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EXAMINER

HAMILTON, LALITA M

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANI K. YADAV-RANJAN

Appeal 2009-0305
Application 09/721,728
Technology Center 3600

Decided:¹ March 11, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-19, 21-39, and 41 which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed to process and device for conducting electronic transactions (Specification, 1:19). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method for conducting a transaction using a medium based on a receipt having payment remittance information, comprising:
 - enabling a payor to authorize a payment due on the receipt to a payee;
 - associating the payment with the payment remittance information;
 - communicating the payment instructions directly to the payee to initiate payment of the amount; and
 - wherein the payment remittance information is arranged within a data structure, the data structure comprising one or more data fields to hold data that the payor can enter, and the payment remittance information further comprises a structured remittance data that is kept hidden from the payee.

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejections:

Delfer, III	US 5,496,991	Mar. 5, 1996
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The following rejection is before us for review:

1. Claims 1-19, 21-39, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Delfer, III.

THE ISSUE

The issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections under 35 U.S.C. § 102(b).

This issue turns on whether Delfer, III discloses the claimed limitation requiring “structured remittance data that is kept hidden from the payee.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Delfer, III discloses an automated remittance system and method whereby consumer’s preauthorizations are obtained by a billing system provider to initiate transfer of funds from the consumer account to the vendors account. (Abstract).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Delfer, III discloses that a bill 4 or remittance document which is used for payment by the consumer is pre-addressed for mail return to the vendor or the billing service provider. (Col. 4:50-5:7).

FF3. Delfer, III does not disclose at column 4, lines 1-15 or column 6, lines 30-50 that “structured remittance data that is kept hidden from the payee.”

FF4. Delfer, III discloses that the remittance document includes encoded information, the unique current billing indicium, which is in the form of a bar code (Col. 5:13-19). Delfer, III does not disclose who generated the bar code or that the encoded information is kept hidden from the payee.

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Delfer, III is improper because the reference fails to disclose the claimed limitation requiring “structured remittance data

that is kept hidden from the payee.” The Appellant argues that the Examiner’s assertion that Delfer, III does disclose such a claimed limitation is only conjecture (Br. 12).

In contrast the Examiner has determined that Delfer, III at column 4, lines 1-15 and column 6, lines 30-50 does disclose that “structured remittance data that is kept hidden from the payee.” (Ans. 6-7).

We agree with the Appellant. Delfer, III does not disclose at column 4, lines 1-15 and column 6, lines 30-50 any “structured remittance data that is kept hidden from the payee” (FF3) despite the Examiner’s assertions. While Delfer, III does disclose that the remittance document includes encoded information, it is not disclosed who generated the encoded information or that it is hidden from the payee (FF4) who generated the bill itself. Delfer, III simply fails to disclose the claim limitation requiring “structured remittance data that is kept hidden from the payee.” For the above reasons, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Delfer, III is not sustained.

The Appellant argues that rejection of independent claims 2, 21, and 22 under U.S.C. § 102(b) as being anticipated by Delfer, III is improper for the same reasons as claim 1 since those claims also include the same limitation requiring “structured remittance data that is kept hidden from the payee.” For the same reasons addressed above in claim 1, the rejection of claims 2, 21, and 22 under U.S.C. § 102(b) as being anticipated by Delfer, III is therefore not sustained. The rejection of dependent claims 3-19, 23-39, and 41 under U.S.C. § 102(b) is also not sustained since they each depend from an independent claim of which the rejection has not been sustained for the reasons above.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-19, 21-39, and 41 under 35 U.S.C. § 102(b) as being anticipated by Delfer, III.

DECISION

The Examiner's rejection of claims 1-19, 21-39, and 41 is not sustained.

REVERSED

hh

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